

Application No.: 10/698,100  
Amendment Dated: May 9, 2005

#### REMARKS

Reconsideration of the merits of the application is respectfully requested in light of the remarks that follow.

#### **Rejection over Desai in view of Edwards**

Claims 1, 3-7, 11-14, 16-23 and 25-30 are rejected under 35 USC §103 as allegedly being unpatentable over U.S. Patent No. 6,231,591 (Desai) in view of U.S. Patent No. 5,599,294 (Edwards).

With respect to claims 13 and 29, the Examiner states that Desai discloses a device for delivering a denervating agent to a prostate gland comprising: a shaft for insertion into the urethra in proximity to the prostate gland, a needle within the shaft, the needle defining a lumen, an actuator to cause the needle to extend through the hole into the prostate gland when the shaft is inserted in proximity to the prostate gland and a denervating agent delivery assembly to cause the denervating agent to pass through the lumen and into the prostate gland when the shaft is inserted in proximity to the prostate gland and the needle is extended out into the prostate gland, **but is silent with respect to the shaft defining a hole on one side of the shaft in proximity to a distal tip of the shaft and wherein a distal end of the needle is extendable through the hole out of the side of the shaft and into the prostate gland.** The Examiner then relies on Edwards to teach the missing element, and states that it is obvious to combine the two references.

Applicant respectfully submits that one of skill in the art would not have been motivated to combine the teachings of Desai with Edwards in the way suggested by the Examiner because it would render the device of Desai unworkable for its intended purpose. The various devices illustrated in Desai include electrodes or sheaths for electrodes that are bent at the end where they are to make contact with the body tissue to be treated. For example, see the discussion at column 14, lines 47-60, and column 16, lines 5-33; and figures 21 and 22. The electrodes of Desai are either designed bent, or are bent by their respective covering sheath. This causes the electrode portion that will be contacting the tissue to be treated to be contacted when the electrode is extended out the end of the device. If the devices of Desai were modified, as suggested by the Examiner, to incorporate the feature of Edwards, the electrode portion of Desai would no longer be in contact with the correct tissue.

Application No.: 10/698,100  
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According to MPEP § 2143.01, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. The Examiner's suggested modification would render the devices of Desai unsatisfactory for their intended purpose because they would not contact the intended tissue to be treated. The working portion of the electrode would either come back out the tissue, or be in contact with the tissue at the wrong location, for example.

Because there is no suggestion to combine the references, claims 13, 14, 16-23 and 25-30 are not obvious over Desai in view of Edwards.

With respect to claims 1, 3-7, 11, and 12, the Examiner asserted that the apparatus of Desai and Edwards was considered to be inherently capable of performing the recited method claims. Applicant respectfully asserts therefore that because the apparatus of Desai and Edwards is not obvious, there is no device that is inherently capable of performing the recited method. Therefore, Applicant respectfully asserts that claims 1, 3-7, 11, and 12 are also not obvious over Desai in view of Edwards.

Applicant therefore respectfully requests that the rejection of claims 1, 3-7, 11-14, 16-23 and 25-30 under 35 USC §103 as allegedly being unpatentable over U.S. Patent No. 6,231,591 (Desai) in view of U.S. Patent No. 5,599,294 (Edwards) be withdrawn.

**Rejection over Desai in view of Edwards and Schmidt**

Claims 2, 8-10, 15, and 24 are rejected under 35 U.S.C. § 103 as allegedly being unpatentable over Desai in view of Edwards in further view of U.S. Patent No. 6,365,164 (Schmidt). Applicant respectfully traverses this rejection.

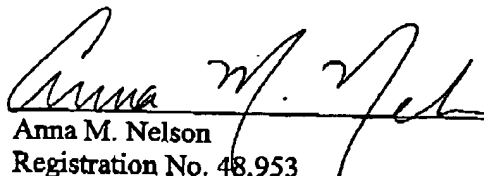
Applicant reiterates the comments offered above, and submits that Schmidt fails to remedy the shortcomings of Desai and Edwards. Therefore, this rejection should be withdrawn as well.

Application No.: 10/698,100  
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In view of the foregoing remarks, it is believed that the application is now in condition for allowance and notice of this, in the form of a notice of allowance is respectfully requested.

Respectfully submitted,

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